

REMARKS

In an Office Action mailed on February 18, 2005, the Examiner acknowledged having considered the prior arguments of Applicant, but deemed those arguments moot in view of the Examiner's new grounds of rejection. Applicant understands the Examiner's statement to mean that all prior bases for rejection of any claim have been overcome except to the extent such bases are incorporated in the Examiner's new grounds of rejection. The Examiner: (1) rejected claims 18 and 19 under 35 U.S.C. § 112, ¶ 2; (2) rejected claims 23 and 24 as anticipated under 35 U.S.C. § 102(b) by Buttner-Janz (U.S. Pat. No. 5,556,431) ("Buttner-Janz"); (3) rejected claims 10, 11, 17, 19, 20, and 21-23 as anticipated under 35 U.S.C. § 102(b) by Baumgartner (U.S. Pat. No. 5,755,797) ("Baumgartner"); (4) rejected claims 10, 11, 19, 20, 23, and 24 as anticipated under 35 U.S.C. § 102(b) by Bristol-Myers Squibb Co. (EP 0 577 179 A1) ("Bristol-Myers"); and (5) objected to claims 12-16 as each being dependent from rejected base claim but allowable if rewritten in independent form including all limitations of the base claim.

By this Response, Applicant amends claims 10, 13, 17-21, 23, and 24. A complete listing of claims is set forth in the section above entitled AMENDMENTS TO THE CLAIMS, showing additions and deletions to the claims currently being amended.

For greater clarity, claim 10 is amended to recite "a cage and a substantially spherical body or ball" instead of "at least one cage and at least one substantially spherical body or ball" in accordance with and reliance on the principle that the term "a" in open-ended claims containing the transitional phrase "comprising" means "one or more." *E.g., KCJ Corp. v. Kinetic Concepts, Inc.*, 223 F.3d 1351, 1356 (Fed. Cir. 2000).

Claims 17, 20, and 24 are amended to clarify the claim and not for reasons of patentability. Except as expressly stated below, the additional amendments to claim 10 and the amendments to claims 13, 18, 19, 21, and 23 are made to clarify the claims and not for reasons of patentability.

Also, by this Response, Applicant respectfully seeks allowance of pending claims 1-24 for at least the following reasons.

(1) Rejection of Claims 18 and 19 Under 35 U.S.C. § 112, ¶ 2

The Examiner rejected dependent claims 18 and 19 under paragraph 2 of 35 U.S.C. § 112 based on her conclusion that claims 18 and 19, which depend from claim 10 and claim the cage of claim 10 to comprise one or two components, contradict claim 10. In support, the Examiner asserted that the specification and drawings did not support a claim “for one spherical body to protrude through two components, so as to protrude from opposite sides of the cage.”

Without conceding that such rejection was proper, Applicant has amended claims 18 and 19 to clarify the claims in a way responsive to the Examiner’s basis for such rejection. Applicant has amended claim 18 to claim a “prosthesis compris[ing] two cages” instead of a “cage consist[ing] of two substantially identical single components.” In addition, Applicant has amended claim 19 to delete the requirement that the “cage consists of one single component or several single components.” Because claim 10 is an open-ended claim requiring “a” cage, as discussed above claim 19 as amended continues to read on a prosthesis having one cage or

several cages. In addition, although the amendments to claims 18 and 19 broaden the scope of such claims, amended claims 18 and 19 remain fully supported by the specification and the drawings.

As amended, claims 18 and 19 are fully consistent with claim 10 and are definite with respect to the requirement that the substantially spherical bodies or balls of claim 10 protrude at both opposite sides of the elongated plane of the cage, even in the case of a prosthesis having two cages. Accordingly, Applicant respectfully submits that no basis for rejection of amended claims 18 and 19 under paragraph 2 of 35 U.S.C. § 112 exists.

(2) Rejection of Claims 23 and 24 Under 35 U.S.C. § 102(b)

The Examiner rejected claims 23 and 24 under 35 U.S.C. § 102(b) as anticipated by Buttner-Janz. As part of the basis for that rejection, the Examiner alleged that Buttner-Janz discloses a cage and a spherical body freely rotatable about its center so as to be movable in two directions in the plane of the cage. Applicant respectfully disagrees with the Examiner's characterization of Buttner-Janz. Nevertheless, Applicant has amended claim 23 to clearly distinguish the invention of claims 23 and 24 from Buttner-Janz.

Buttner-Janz discloses a core 3 having spherical articular surfaces 4 and an edge rim 5 that limits the core's range of movement. Col. 2, ll. 42-44. In the February 18, 2005 Office Action, the Examiner contends that core 3 is a prosthesis, edge rim 5 is a cage, and articular surfaces 4 are a spherical body. The disclosure in Buttner-Janz clearly shows that core 3, the articular surfaces 4 of core 3, and edge rim 5 of core 3 are a unitary structure, and that any rotation of core 3 and its articular surfaces 4 will involve an equivalent rotation of edge rim 5.

Thus, there is no rotation of core 3 or its articular surfaces 4 within edge rim 5. The Examiner implicitly acknowledges that conclusion in the February 18, 2005 Office Action with the statement that “body 4, is rotatable, when rotating, it rotates the entire prosthesis.”

Applicant has amended claim 23 to claim a “spherical body or ball disposed ... rotatably ... within the cage.” Although the amendment to claim 23 broadens the scope of the claim, amended claim 23 remains fully supported by the specification and the drawings. As discussed above, Buttner-Janz does not disclose a spherical body or ball disposed rotatably within a cage. Because Buttner-Janz does not disclose every limitation of claim 23, claim 23 is not anticipated by Buttner-Janz, and no basis has been provided for a rejection under 35 U.S.C. § 102(b). *E.g., Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987).

Claim 24 depends from claim 23 and therefore incorporates by reference all the limitations of claim 23. 35 U.S.C. § 112, ¶ 4. Because Buttner-Janz does not disclose every limitation of claim 23, Buttner-Janz necessarily does not disclose every limitation of claim 24. Accordingly, claim 24 is not anticipated by Buttner-Janz, and no basis has been provided for a rejection under 35 U.S.C. § 102(b). *E.g., Verdegaal Bros.*, 814 F.2d at 631.

(3) Rejection of Claims 10, 11, 17, 19, 20, and 21-23 Under 35 U.S.C. § 102(b)

The Examiner rejected claims 10, 11, 17, 19, 20, and 21-23 as anticipated under 35 U.S.C. § 102(b) by Baumgartner. As part of the basis for that rejection, the Examiner alleged that Baumgartner discloses a cage and a spherical body freely rotatable about its center within the cage. Applicant respectfully disagrees with the Examiner’s characterization of Baumgartner.

Nevertheless, Applicant has amended claims 10, 21, and 23 to clearly distinguish the inventions of claims 10, 11, 17, 19, 20, and 21-23 from Baumgartner.

Baumgartner discloses a support member 7 in the form of a ball with a single open duct 14 passing through it. Col. 3, ll. 55-57, Col. 4, ll. 60-64. Support member 7 can be disposed on a flexible, ribbon-like, or string-like support 20 with stop parts 21. Col. 5, ll. 29-31. Figure 6 clearly shows that support 20 passes through duct 14 of support member 7. From the disclosure of Baumgartner, it is clear that any rotation of support member 7 about its center is limited to rotation of support member 7 about a single axis that is coaxial with the longitudinal axis of the single duct 14.

In the February 18, 2005 Office Action, the Examiner contends that support 20 and stop parts 21 are a cage and that support member 7 is a spherical body or ball. The Examiner further contends that support member 7 is freely rotatable about its center, referring to duct 14, and that such rotation can occur in two directions, clockwise and counterclockwise. The Examiner's contention regarding rotation of support member 7 implicitly acknowledges that such rotation occurs only about the longitudinal axis of duct 14.

Applicant has amended claims 10, 21, and 23 to require that the substantially spherical body or ball be rotatable "about at least two axes through its center." Although the amendments to claims 10, 21, and 23 broaden the scope of the claims, amended claims 10, 21, and 23 remain fully supported by the specification and the drawings. As discussed above, Baumgartner at most discloses a spherical body or ball rotatable about a single axis, and does not disclose a spherical body or ball rotatable "about at least two axes through its center." Because Baumgartner does not disclose every limitation of claims 10, 21, and 23, those claims are not anticipated by

Baumgartner, and no basis has been provided for their rejection under 35 U.S.C. § 102(b). *E.g.*, *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987).

Claims 11, 17, 19, and 20 depend directly or indirectly from claim 10, and claim 22 depends from claim 21. Therefore, claims 11, 17, 19, and 20 incorporate by reference all the limitations of claim 10, and claim 22 incorporates by reference all the limitations of claim 21. 35 U.S.C. § 112, ¶ 4. Because Baumgartner does not disclose every limitation of claim 10, Baumgartner necessarily does not disclose every limitation of claims 11, 17, 19, and 20. Because Baumgartner does not disclose every limitation of claim 21, Baumgartner necessarily does not disclose every limitation of claim 22. Accordingly, claims 11, 17, 19, 20, and 22 are not anticipated by Baumgartner, and no basis has been provided for their rejection under 35 U.S.C. § 102(b). *E.g.*, *Verdegaal Bros.*, 814 F.2d at 631.

(4) Rejection of Claims 10, 11, 19, 20, 23, and 24 Under 35 U.S.C. § 102(b)

The Examiner rejected claims 10, 11, 19, 20, 23, and 24 as anticipated under 35 U.S.C. § 102(b) by Bristol-Myers. As part of the basis for that rejection, the Examiner alleged that Bristol-Myers discloses a cage and a spherical body freely rotatable about its center within the cage. Applicant respectfully disagrees with the Examiner's characterization of Bristol-Myers. Nevertheless, Applicant has amended claims 10 and 23 to clearly distinguish the inventions of claims 10, 11, 19, 20, 23, and 24 from Bristol-Myers.

Bristol-Myers discloses a connecting element 6 and spherical spacers 2 containing a single central bore 3 through which connecting element 6 extends. Col. 3, ll. 18-20, 29-31, Figs. 2, 3. From the disclosure of Bristol-Myers, it is clear that any rotation of spherical spacer 2

about its center is limited to rotation of spherical spacer 2 about a single axis that is coaxial with the longitudinal axis of the single central bore 3.

In the February 18, 2005 Office Action, the Examiner contends that connecting element 6 is a cage, and that spherical spacer 2 is freely rotatable about its center within connecting element “cage” 6. The Examiner acknowledges that the rotation of spherical spacer 2 is “about central bore 3” of the spherical spacer 2 providing movement in two directions, “clockwise and counter clockwise” about connecting element 6. The Examiner’s contention regarding rotation of connecting element 6 implicitly acknowledges that such rotation occurs only about the longitudinal axis of central bore 3.

Applicant has amended claims 10 and 23 to require that the substantially spherical body or ball be rotatable “about at least two axes through its center.” Although the amendments to claims 10 and 23 broaden the scope of the claims, amended claims 10 and 23 remain fully supported by the specification and the drawings. As discussed above, Bristol-Myers at most discloses a spherical body or ball rotatable about a single axis, and does not disclose a spherical body or ball rotatable “about at least two axes through its center.” Because Bristol-Myers does not disclose every limitation of claims 10 and 23, those claims are not anticipated by Bristol-Myers, and no basis has been provided for their rejection under 35 U.S.C. § 102(b). *E.g.*, *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987).

Claims 11, 19, and 20 depend directly or indirectly from claim 10, and claim 24 depends from claim 23. Therefore, claims 11, 19, and 20 incorporate by reference all the limitations of claim 10, and claim 24 incorporates by reference all the limitations of claim 23. 35 U.S.C. § 112, ¶ 4. Because Bristol-Myers does not disclose every limitation of claim 10, Bristol-Myers necessarily does not disclose every limitation of claims 11, 19, and 20. Because

Bristol-Myers does not disclose every limitation of claim 23, Bristol-Myers necessarily does not disclose every limitation of claim 24. Accordingly, claims 11, 19, 20, and 24 are not anticipated by Bristol-Myers, and no basis has been provided for their rejection under 35 U.S.C. § 102(b). *E.g., Verdegaal Bros.*, 814 F.2d at 631.

(5) Objection to Claims 12-16 as Depending from Rejected Base Claims

The Examiner objected to claims 12-16 as each being dependent from a rejected base claim but allowable if rewritten in independent form including all limitations of the base claim. Applicant appreciates the Examiner's recognition of the patentability of claims 12-16, but in light of the foregoing discussion, Applicant contends that all pending claims are allowable. Accordingly, Applicant respectfully defers rewriting claims 12-16 in independent form pending further action in this application.

In view of the reasons given above, Applicant respectfully requests the timely allowance of the pending claims 1-24.

Further, the Office Action contains a number of statements reflecting characterizations of the claims and/or related description. Regardless of whether any such statements are addressed above, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

The Commissioner is hereby authorized to charge any excess claim fees to Deposit Account No. 50-3534. The Commissioner is hereby authorized to charge any fees deemed to be due or credit any overpayment to Deposit Account No. 50-3534, upon which the undersigned is authorized to sign.

Respectfully submitted,

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